

## REMARKS

The Examiner is thanked for the performance of a thorough search.

By this amendment, Claims 2, 16-19, 22, and 36-39 have been cancelled. Claims 1, 3-10, 15, 20, 21, 23-30, 35, 40-42 have been amended. No claims have been added. Hence, Claims 1, 3-13, 15, 20-21, 23-35, and 40-42 are pending in the application.

## SUMMARY OF THE REJECTIONS/OBJECTIONS

A restriction requirement has been issued.

The specification is objected to because of the inclusion of a typographical error.

Claims 3, 10, 23, and 30 are objected to because of the inclusion of a typographical error.

Claims 1, 10, 12-13, 21, 30, and 32-33 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application 2002/0065774 by Young et al. ("*Young*").

Claims 2, 4-5, 9, 22, 24-25, and 29 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Young* in view of U.S. Patent 6,192,380 by Light et al. ("*Light*").

The rejections are respectfully traversed.

## RESPONSE TO RESTRICTION REQUIREMENT

Applicants elect, without traverse, claims in species 1, namely, Claims 1-13, 16-19, 21-33, and 36-39. Applicants note the four species identified in the Office Action share numerous claims, such as Claims 1, 9-13, 21, and 36-39. The only difference between the species is that species 1 includes Claims 2-8, species 2 includes Claims 15 and 35, species 3 includes Claims 20 and 40, and species 4 includes Claims 41 and 42. If Claim 1 is allowed in a subsequent Office Action, it is respectfully submitted that any claim that properly depends from Claim 1 is allowable, even if it is assigned a different species than Claim 1, as such a dependent claim would have a narrower scope and directly depend from subject matter allowed in Claim 1.

## **RESPONSE TO OBJECTIONS TO THE SPECIFICATION AND CLAIMS**

The Applicants have amended their specification to remove the inclusion of a typographical error that was inadvertently introduced. Consequently, it is respectfully submitted that the objections raised by the Office Action regarding the specification have been overcome.

The Applicants have amended the claims, including Claims 3, 10, 23, and 30, to improve the readability of the claims and to remove the inclusion of typographical errors that were inadvertently introduced. Consequently, it is respectfully submitted that the objections raised by the Office Action regarding the presence of informalities in Claims 3, 10, 23, and 30 have been overcome.

## **RESPONSE TO REJECTIONS BASED ON THE PRIOR ART**

Each of the pending claims is patentable over the cited art, even if it were proper to combine the cited art, because each of the pending claims features at least one element that is neither taught, disclosed, or suggested by the cited art, either individually or in combination.

Claims 1 and 21 feature the elements of:

“wherein the step of storing said data records comprises:  
receiving content provided by one or more services accessed by the device;  
identifying, within said content, one or more data items associated with  
said particular type of information; and  
generating one or more data records that contain said one or more data  
items;”

The above elements are not disclosed, taught, or suggested by the cited art, either individually or in combination.

*Young* does not disclose, teach, or suggest the element of “identifying, within said content, one or more data items associated with said particular type of information.”

*Young* describes an approach wherein electronic wallet information is stored externally from a mobile phone and a merchant. However, *Young* makes clear that “the electronic wallet comprises payment data related to the user previously entered by the user” (See paragraph 57, lines 1-2). *Young* further states that “the wallet may contain previously-entered information related to various payment options (e.g., various credit card numbers

and related information, and various debit card numbers and related information” (See paragraph 57, lines 19-23).

The entire disclosure of *Young* requires that data stored in electronic wallet 17 be manually entered prior to use. On the other hand, the above elements make clear that the one or more data items are identified within content that is provided by one or more services accessed by the device. *Young* lacks any suggestion of the above-quoted elements.

While Claims 1 and 21 have been rejected solely on the basis of *Young*, *Light* also fails to disclose, teach, or suggest the element of “identifying, within said content, one or more data items associated with said particular type of information.” *Light* describes an approach for automatically filling-in a web form with data. However, *Light* makes clear that the learning subunit 370 only “learns” data to fill in a web form that is manually entered by the user. (See Col 4., lines 15-25; Col. 4, lines 30-36; FIG. 5B). Indeed, *Light* states that “the system may only learn from user input.” Consequently, *Light* also does not disclose, teach, or suggest the above elements.

The Office Action alleges that *Light* (at Col. 4, lines 15-24; Col. 6, line 43-Col. 7, line 19) teaches identifying, within content, data items associated with a particular type of information by explaining that the “user completes the form, adds new data if necessary”. However, Claims 1 and 21 feature the steps of:

“receiving content provided by one or more services accessed by the device;  
identifying, within said content, one or more data items associated with said particular type of information”

First, as explained above, *Light* does not even suggest the above two elements, as the system of *Light* may only learn from user input, not from identifying one or more data items within content provided by one or more services accessed by the device. Second, even the explanation offered by the Office Action does not satisfy the claims because the data items are not identified within content provided by one or more services accessed by the device, but rather by data supplied by the user (i.e., “user completes the form, adds new data if necessary”).

As each of Claims 1 and 21 are not disclosed, taught, or suggested by either *Young* or *Light*, either individually or in combination, it is respectfully submitted that (a)

Claims 1 and 21 are patentable over the cited art, and (b) Claims 1 and 21 are in condition for allowance.

**CLAIMS 3-13, 15, 20, 23-35, AND 40-42**

Claims 3-13, 15, 20, 23-35, and 40-42 are dependent claims, each of which depends (directly or indirectly) on one of Claims 1 and 21. Each of Claims 3-13, 15, 20, 23-35, and 40-42 is therefore allowable for the reasons given above for the claim on which it depends. In addition, each of Claims 3-13, 15, 20, 23-35, and 40-42 introduces one or more additional limitations that independently render it patentable. However, due to the fundamental differences already identified, to expedite the positive resolution of this case a separate discussion of those limitations is not included at this time, although the Applicants reserve the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

**REJECTION UNDER 35 U.S.C. § 103(A) IS NOT SUSTAINABLE  
BECAUSE YOUNG AND LIGHT ARE NOT PROPERLY COMBINED**

A rejection of Claims 4-5, 9, 24-25, and 29 under 35 U.S.C. § 103(a) based upon a combination of *Young* and *Light* is improper and may not be sustained. The Office Action, in citing a portion of the cited art that contains a teaching, suggestion, or motivation for combination, states “It would have been obvious to one of ordinary skill in the art at the time of the invention to have the remote electronic wallet taught by *Young* include the features of receiving content provided by the plurality of services, identifying data items in the content associated with the particular information, and storing data records containing the items, as taught by *Light*, because *Young*’s remote electronic wallet would then learn new information each time it is encountered in a form, as taught by *Light* (Col. 6, line 43- Col. 7, line 19), alleviating the burden and possibility of making mistakes that are common with having to re-enter form data over and over again, as taught by *Light* (Coo. 1, lines 28-40).”

Nothing in the cited portion of *Light* suggests that the approach of *Light* could be augmented by a combination with *Young*. For example, the electronic wallet of *Young* is maintained separately from the transaction portal server that “comprises web pages” and

performs web server functionality (See Fig. 1; paragraph 35); however, the approach of *Light* is performed in a server 130 that serves web pages. There is no discussion in *Light* of how the approach of *Light* may be performed on an entity that does not serve web page, such as the electronic wallet of *Young*. Absent a showing of a teaching or suggestion to combine the teachings, a rejection under 35 U.S.C. § 103(a) is inappropriate hindsight-based analysis. MPEP § 2143.01.

Accordingly, it is respectfully submitted that any rejection of Claims 4-5, 9, 24-25, and 29 under 35 U.S.C. § 103(a) based upon a combination of *Young* and *Light* is inappropriate because there is no motivation to combine *Young* and *Light*. Therefore, the rejection may not be sustained and Claims 4-5, 9, 24-25, and 29 are in condition for allowance.

### CONCLUSION

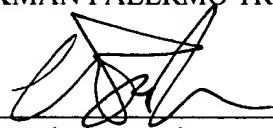
For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any fee shortages or credit any overages Deposit Account No. 50-1302.

Respectfully submitted,

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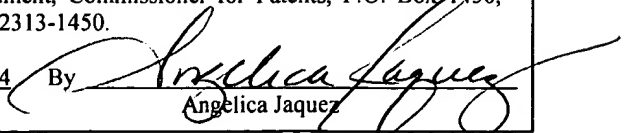
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#### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:  
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On August 5, 2004

By

  
Angelica Jaquez